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10/699,780

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Sue Feng

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1619

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/699,780 | Applicant(s) FENG ET AL. | |
| | Examiner JYOTHSNA A. VENKAT | Art Unit 1619 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/18/09.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 96,142,167,170,175,203 and 206 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 96,142,167,170,175,203 and 206 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/18/09</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Receipt is acknowledged of remarks and IDS filed on 11/18/09 and terminal disclaimer also filed on 11/18/09.

Status of claims

Claims 1-95, 97-141, 143-166, 168-169, 171-174, 176-202 and 204-205 have been cancelled. Claims 96, 142, 167, 170, 175, 203 and 206 are currently examined in the application.

Claim Rejections - 35 USC § 112

The rejection of claims 96, 142, 167, 170, 175, 203 and 206 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for the species **“ethylenediamine/stearyl dimer tallate copolymer” is hereby withdrawn since the specification at page 39 under examples describe the species " ethylenediamine/tall oil dimer acid/stearyl alcohol copolymer.**

Double Patenting

The obviousness-type double patenting rejection of claims 96, 142, 167, 170, 203 and 206 over U. S. Patents Nos. 6,716,420, 7,008,619, 6,402,408, 6,835,399, 6,869,594, 6,881,400, 6,960,339, 6,979,469, 7,008,629, 7,011,823, 7,144,582, 6,432,391, 7,025,953, 7,052,681, and 7,023,552 is **hereby withdrawn in view of terminal disclaimer submitted on 5/20/09** and applicants' remarks and exhibit 5.

The rejection of claims 96 and 203 on the ground of non- statutory obviousness-type double patenting as allegedly being unpatentable over claims 1 and 2 of U.S. Patent No. 7,008,619;

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The rejection of claims 96, 142, 167, 170, 203, and 206 on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1 and 13 of U.S. Patent No. 7,276,547 in view of Collin and Murphy;

The rejection of claims 96, 142, 167, 170, 203, and 206 on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 18, 20, and 21 of U.S. Patent No. 7,314,612 in view of Collin and Murphy;

The rejection of claims 96, 142, 167, 170, 203, and 206 on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1, 5, and 18 of U.S. Patent No. 7,351,418 in view of Collin and Murphy;

The rejection of claims 96, 142, 167, 170, 203, and 206 on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1, 29, and 30 of U.S. Patent No. 7,410,636 in view of Collin and Murphy is **herby withdrawn in view of terminal disclaimer submitted on 11/18/09.**

Claim Rejections - 35 USC § 103

Claims 96, 142, 167, 170, 203 and 206 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of 5,783,657 ('657) and WO 01/17488 ('488).

Patent '657 teaches polymer having gel consistency and these gels are useful in personal care products where in some self-supporting consistency is desired. See the abstract and see cols. 3-4 and see col.3, lines 31-36 where patent teaches that these polymers are useful in cosmetic art. Patent at col.4, ll 20-25 teaches ester –terminated polyamide of formula I (ETPA)

The species of claim 96 belong to the genus of this polymer. The species is formed from ethylenediamine, stearyl alcohol and tall oil fatty acid or linoleic acid. Patent at col.5, ll 1-

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20 describes the definition of R1 and the carbon range of 16-22 is the preferred range. Patent at col.5, ll 23-33 teaches the definition of R2 and at col.5, ll 39-40 teaches that typical unsaturated acids are linoleic acids and at col.5, ll 44-46 teaches that tall oil fatty acid is a preferred source of long-chain fatty acids. Patent at col.7, ll 24-35 teaches the preparation of ETPA . The starting materials for the ETPA are alcohols, amines and carboxylic acids are preferred starting materials (col.7, ll 24-25). Patent at paragraph bridging col.s 7-8 describes the monoalcohols and at col.8, line 3 describes preferred R1 and this includes stearyl alcohol (*one of the reactants, namely alcohols for the formation of both the claimed species*). Patent at col.8, ll 37-68 describes the second component, which is diacid and at col.9, ll 5-15 describes the acids and this includes linoleic acid (*one of the reactants, namely acids for the formation of ethylenediamine/stearyl dimer dilinoleate copolymer*) and describes the preferred fatty acid as tall oil fatty acid (*one of the reactant, namely acids for the formation of ethylenediamine/stearyl dimer tallate copolymer*). Patent at col.9, ll 24-28 describes that polymerized fatty acids are sold under the trade name UNIDYME®. Patent at col.10, ll 18-36 describes exemplary diamines and the ethylenediamine (*one of the reactants, namely amines for the formation of both the claimed species*) is the first diamine described at line 20. Patent at col.12 through col.13, line 45 describes in detail the preparation of ETPA resins.

Patent '657 at col.14, lines 30-42 teaches that the polymer can be formulated into various personal care products. This includes deodorant, eye make-up, lipstick, foundation make-up, baby-oil, skin moisturizers, sun care products, lip balm, ethnic hair care products (claim 96).

Patent '657 at col.15, ll 11-15 teaches gel formation between ETPA and low polarity liquid like hydrocarbons or oils. This reads on claimed fatty phase of claim 142.

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Patent '657 at col.15, ll 1-10 teaches the amount of ETPA resin as 1-50%.

Patent '657 at col.16, ll 43-45 teaches the gels of the invention being self supporting and they retain the shape at room temperature and in the absence of shear.

Patent '657 at col.17, ll 25-26 suggests adding ingredients that are conventionally incorporated into personal care products and suggests that gels which are formed from ETPA resin and low-polarity liquids (oils), colorants (claim 96 and 203), emulsifiers (also known as surfactants) and fillers. The difference between patent '657 and instant application is patent does not teach claimed polysaccharide resin (claim 167) and claimed film former (claim 170) and the composition being a nail composition.

However WO '488 teaches cosmetic compositions containing polysaccharide resins, which provide transfer resistant, long wearing and water resistant properties. See the abstract. WO '488 at page 3, ll 8-16 teaches that the combination of polysaccharide resin and film former other than polysaccharide resin provide transfer resistant property to cosmetic composition such as mascara, eyeliner and at ll 19-28 teaches forming transfer resistant film by applying to keratinous substances such as skin, hair, nails. WO '488 at page 7, first paragraph teaches various properties and this includes ingredient dispersing in formulations like foundations... nail enamels (claim 206). WO '488 at page 17, ll 14-21 teaches pigment dispersing properties and the pigment dispersing property results in higher efficacy of pigment. Higher efficacy of pigment implies providing more color.

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare cosmetic composition using the two species belonging to polyamide resin and colorants taught by patent '657 which has gel property and also structured

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property and combine with polysaccharide resin and film former taught by WO '488 with the reasonable expectation of success that the compositions have the advantage of providing the consumer stable cosmetic products having structured property and gel property because of the polyamide resin of patent '657 and also provide intense color due to the presence of coloring agent and combining with polysaccharide resin and film former provide additional benefit of transfer resistant, long wearing and water resistant properties and also increase the efficacy of coloring agent thereby providing intense color to the compositions. This is a prima facie case of obviousness.

Response to Arguments

Applicant's arguments filed 11/18/09 have been fully considered but they are not persuasive.

Applicants' argue:

"The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness." M.P.E.P. §2144.08 (citing In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not render the compound obvious."). While Pavlin discloses an ester-terminated polyamide (ETPA) of formula (I), there is no disclosure of the claimed species of structuring polymers, e.g., Uniclear, recited in claims 96, 142, 167, 170, 175, 203 and 206. Moreover, there is no teaching or suggestion in Pavlin that would direct one of ordinary skill in the art to choose

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Uniclear rather than one of the other structuring polymers encompassed by formula (I). In fact, Pavlin would direct one of ordinary skill in the art away from Uniclear.

Uniclear is derived from the condensation polymerization of: about 76.62 wt% of a dimer acid (Empol 1011), about 5.87 wt% of an amine (ethylene diamine), and about 17.51 wt% of an alcohol (Alfol-18, i.e., stearyl alcohol).¹ See Information Relevant to the Use and Availability of UNICLEAR 80/100, attached herewith as Exhibit 1. From a review of Pavlin, the closest ester-terminated polyamide (ETPA) to Uniclear is Example 8. See Pavlin, col. 20, line 55 to col. 21, line 14. Example 8 is an ETPA derived from 76.4 wt% of the dimer acid Empol 1008, 5.9 wt% of ethylene diamine, and 19.7 wt% of stearyl alcohol. See id. Example 8, however, reports that gels formed from this Uniclear-like structurant made from 19.7 wt% stearyl alcohol were opaque, not clear. See id. at col. 21, lines 12-14. Further, Example 8 warns that "[t]his example shows that there is a lower limit to the alcohol concentration that can be used in an ETPA, and still obtain a transparent gel therefrom." See id. at col. 20, lines 60-62. In view of the fact that Uniclear is an ETPA that is derived from only about 17.51 wt% stearyl alcohol, it is below the lower limit taught by Pavlin for making clear gels. Accordingly, a person of ordinary skill in the art would have been directed away from using Uniclear as the structuring polymer by this disclosure in Pavlin.

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A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See M.P.E.P. § 2141.02(VI). Indeed, the totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is "strong evidence of unobviousness." In re Hedges, 783 F.2d 1038, 1041, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986). When the disclosure of Pavlin is considered in its entirety, as required, see M.P.E.P. § 2141.02(VI), a person would have been directed away from Uniclear by Pavlin teaching that a stearyl alcohol concentration of 19.7 wt% or below in an ETPA would form an undesirable opaque gel. This teaching away in Pavlin would have led one of ordinary skill in the art to other disclosed ETPA structuring polymers with a stearyl alcohol concentration of greater than 19.7 wt%. Thus, common sense would dictate against both selection and addition of Uniclear from among the other ETPA structuring polymer disclosed in Pavlin.

Colin does not rectify the deficiencies of Pavlin discussed above. Thus, Applicants submit that the Examiner failed to establish a prima facie case of obviousness over Pavlin and Collin “.

In response to the above argument, patent ‘657 admitted by applicants’ under example 8, clearly teach species formed from ethylenediamine, stearyl alcohol and polymerized dimer acid. Patent at col.8, line 51 teaches polymerized C36 dimer acid and this is the only exemplified polymerized dimer acid with carbon atoms. Patent at col.9, ll 9-10 teaches preferred acid which

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is tall oil fatty acids. Preferred mono alcohols include stearyl alcohol and cetyl alcohol at col.8, ll 6-8. Example 8 teaches ethylene diamine and thus one skilled in the art would prepare the claimed species from preferred reactants to form the ETPA resin which has gel like consistency. The claimed species is not picked from laundry list instead from preferred reactants and exemplified reactants (emphasis added). Example 8 might teach that the gel was hard, however table 12 also teaches that stearyl terminated polyamide forms clear gels. Accordingly, a person of ordinary skill in the art would have been motivated from using claimed species of '657 by using polymerized C36 dimer acid, ethylene diamine and terminated with stearyl alcohol.

In KSR, the Supreme Court stated that an invention may be found obvious if it would have been obvious to a person having ordinary skill to try a course of conduct:

*When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.
KSR, 550 U.S. at 421.*

Therefore one of ordinary skill in the art would be motivated to prepare compositions by using the species belonging to ETPA of patent '657 that is formed from linoleic acid, stearyl alcohol and ethylenediamine and also the species formed from tall oil fatty acid, stearyl alcohol and ethylenediamine and combine with polysaccharide resin and film former taught by WO '488 with the reasonable expectation of success that the compositions have the advantage of providing the consumer stable cosmetic products having structured property and gel property because of the polyamide resin of patent '657 and also provide intense color due to the presence of coloring agent and combining with polysaccharide resin and film former provide additional benefit of

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transfer resistant, long wearing and water resistant properties and also increase the efficacy of coloring agent thereby providing intense color to the compositions.

Claim 175 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of 5,783,657 ('657) and WO 01/17488 ('488) as applied to claims 96, 142, 167, 170, 203 and 206 above, and further in view of U. S. Patent 6,423,324 ('324).

The references cited above do not teach adding fatty alcohol to the cosmetic compositions. However patent '324 teaches polyamide-based composition and teaches structurally related polyamide resin at paragraph bridging cols. 4-5 and teaches solvent for the polyamide resin and teaches fatty alcohol as the preferred solvent at col.6, ll 22-24. See also col.6, ll 51-55 for octyldodecanol (fatty alcohol). See also examples for octyldodecanol (fatty alcohol).

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare cosmetic composition using the two species belonging to polyamide resin and colorants taught by patent '657 which has gel property and also structured property and combine with polysaccharide resin and film former taught by WO '488 and combine with fatty alcohol taught by patent '324 with the reasonable expectation of success that the compositions have the advantage of providing the consumer stable cosmetic products having structured property and gel property because of the polyamide resin of patent '657 and the addition of fatty alcohol provide the polyamide resin desired firmness resin and also provide intense color due to the presence of coloring agent and combining with polysaccharide resin and film former provide additional benefit of transfer resistant, long wearing and water resistant

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properties and also increase the efficacy of coloring agent thereby providing intense color to the compositions. This is a prima facie case of obviousness.

Response to Arguments

Applicant's arguments filed 11/18/09 have been fully considered but they are not persuasive.

Applicants' argue that Murphy ('324) does not rectify the deficiencies of Pavlin ('657) as discussed above.

In response to the above argument, patent '657 admitted by applicants' under example 8, clearly teach species formed from ethylenediamine, stearyl alcohol and polymerized dimer acid. Patent at col.8, line 51 teaches polymerized C36 dimer acid and this is the only exemplified polymerized dimer acid with carbon atoms. Patent at col.9, ll 9-10 teaches preferred acid which is tall oil fatty acids. Preferred mono alcohols include stearyl alcohol and cetyl alcohol at col.8, ll 6-8. Example 8 teaches ethylene diamine and thus one skilled in the art would prepare the claimed species from preferred reactants to form the ETPA resin which has gel like consistency. The claimed species is not picked from laundry list instead from preferred reactants and exemplified reactants (emphasis added). Example 8 might teach that the gel was hard, however table 12 also teaches that stearyl terminated polyamide forms clear gels. Accordingly, a person of ordinary skill in the art would have been motivated from using claimed species of '657 by using polymerized C36 dimer acid, ethylene diamine and terminated with stearyl alcohol.

One of ordinary skill in the art would be motivated to prepare cosmetic composition using the two species belonging to polyamide resin and colorants taught by patent '657 which has gel property and also structured property and combine with polysaccharide resin and film

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former taught by WO '488 and combine with fatty alcohol taught by patent '324 with the reasonable expectation of success that the compositions have the advantage of providing the consumer stable cosmetic products having structured property and gel property because of the polyamide resin of patent '657 and the addition of fatty alcohol provide the polyamide resin desired firmness resin and also provide intense color due to the presence of coloring agent and combining with polysaccharide resin, film former provide additional benefit of transfer resistant, long wearing and water resistant properties and also increase the efficacy of coloring agent thereby providing intense color to the compositions.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EYLER YVONNE (BONNIE) can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619